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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,714

12/12/2005

Andreas Voigt

ZIMR/0017

7477

26290 7590 06/04/2009
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EXAMINER

VETERE, ROBERT A

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

06/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/535,714	Applicant(s) VOIGT ET AL.	
	Examiner ROBERT VETERE	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-17, 26, 27 and 32 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 18-25, 28-31, 33, 40 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/05;3/06;7/06</u> | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1792

DETAILED ACTION

Election/Restrictions

1. Claims 34-39 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/12/2009.

Drawings

2. The drawings are objected to because applicant has supplied two drawings labeled 2A. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 1792

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-5, 8, 14-17, 26-27 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Seul et al. (US 7,118,900).

Claims 1-2, 8 and 14: Seul teaches a method of modifying microparticles comprising the steps of: immobilizing a bead array in a solid gel, introducing a reaction mixture which modifies the surface of the beads by binding to the beads' surface (claimed coating) and destroying the gel to recover the beads (16:60-17:30; Fig. 7). Seul further teaches that the beads are smaller than 30 μm (11:47-63). The reaction mixture has a higher mobility than the microparticles because the microparticles have been immobilized in the gel. Furthermore, the introduction of the reaction mixture is an induced directional transport.

Claims 3-5: Seul further teaches that the beads are first mixed with a gel-forming agent (claimed "low viscosity form" before a reversible solid gel is formed to immobilize the particles (16:60-67).

Claims 15-17: Seul further teaches that the beads may be colloidal, may have biomolecules attached on their surfaces (claimed biological origin; claimed contain an active compound) (12:15-33).

Claims 26-27: Seul also teaches that the reaction mixture may comprise DNA (see, e.g., 20:8-14) and that the reaction mixture has fluorescent tags (claimed labeled) (17:22-26).

Claim 32: Seul also teaches that the gel is composed of organic polymers (9:33-45).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1792

6. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seul in light of Cunliffe et al. (US 4,107,142).

Claims 9 and 12: Seul teaches that the gel is destroyed to extract the particles, but fails to teach that the viscosity of the gel is lowered to do so. Cunliffe teaches that particles can be removed from a gel by lowering the viscosity of the gel by adding methanol as a dispersing agent (3:57-60). The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have reduced the viscosity of the gel using a dispersing agent to retrieve the beads.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seul and Cunliffe in light of Taylor (US 2004/0265386).

Claim 10: Seul and Cunliffe fail to teach that the viscosity of the gel is reduced by a gel-sol transition. Taylor teaches that a gel-sol transition is a suitable means of lowering a gel's viscosity (¶ 0004). The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a gel-sol transition to lower the viscosity of the gel with the predictable expectation of success.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seul and Cunliffe in light of Navratil et al. (US 4,743,633).

Claim 11: Seul and Cunliffe fail to teach that the viscosity of the gel is reduced by heating the gel. Navratil teaches that heat is a suitable means of lowering a gel's viscosity (17:29-65). The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used heat to reduce the viscosity of the gel with the predictable expectation of success.

Art Unit: 1792

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seul in light of Brautigam et al. (US 4,964,961).

Claim 13: Seul teaches that the gel is destroyed to extract the particles, but fails to teach that the gel is decomposed to extract the particles. Brautigam teaches that particles may be retrieved from a gel by decomposing the gel (2:1-8). The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have decomposed the gel in order to retrieve the beads with the predictable expectation of success.

Allowable Subject Matter

10. Claims 6-7, 18-25, 28-31, 33 and 40-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT VETERE whose telephone number is (571)270-1864. The examiner can normally be reached on Mon-Fri 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on 571-272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Vetere/
Examiner, Art Unit 1792

/Michael Cleveland/
Supervisory Patent Examiner, Art Unit 1792